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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,726	02/04/2004	Terry-Lee M. Fritz	200311549-1	5629
22879	7590	10/20/2005	EXAMINER	
HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			EVANISKO, LESLIE J	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/772,726	Applicant(s) FRITZ ET AL.	
	Examiner Leslie J. Evanisko	Art Unit 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10, 12-16, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2, 5-8, 10 and 14 is/are allowed.
- 6) ☒ Claim(s) 15, 16, 21 and 22 is/are rejected.
- 7) ☒ Claim(s) 3, 4, 12 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 3-4 and 12-13 are objected to because of the following informalities:

With respect to claim 3, it is suggested that the term "a" in line 1 be deleted and replaced with --the-- since the pair of metameric inks were previously recited in claim 2. Note the term "a" in line 1 of claim 4 should likewise be corrected. With respect to claim 12, the term "the same printer" in line 2 has no proper antecedent basis since no printer was ever previously recited. Similarly, in claim 13, the recitation of "a different printer" is also awkward and somewhat confusing since no printer was ever previously recited in the claims.

Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 15-16 and 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Beck (GB 1 407 065). Beck teaches a copy-proof paper and method of preparing comprising printing first and second colored markings on a paper article, wherein the first and second markings are metameric. Note Beck teaches the metameric markings can have the same or a different color appearance when viewed under different light conditions, such as natural daylight or under a tungsten filament lamp in page 3, lines 67-107. To the extent that applicant has clearly defined what is meant by “copier light” in the claims or specification, note that light sources such as tungsten filament lamps are known to be used in photocopiers to flash light onto the original document and therefore can be considered to provide “copier light”. Therefore, since the tungsten filament lamp of Beck can be considered to provide “copier light” and the metameric markings of Beck are capable of having either the same or a different color appearance under this “copier light” as broadly recited, Beck meets the limitations of the claims as recited. Note additionally that since the paper article of Beck includes the metameric markings as recited, it would inherently be a “copy-proof” paper article as recited. Particular attention is invited to page 2, line 22 through page 4, line 33 of Beck.

With respect to claims 15-16, note Beck teaches the metameric markings are capable of having a same color appearance under the tungsten filament lamp (or “copier light”) in lines 94-107.

With respect to claims 21-22, note Beck teaches the metameretic markings are capable of having a different color appearance under the tungsten filament lamp (or “copier light”) in lines 82-93 of page 3.

Allowable Subject Matter

4. Claims 1-2, 5-8, 10, and 14 are allowed.
5. Claims 3-4 and 12-13 are objected to for the reasons set forth above, but would be allowable if rewritten to overcome those objections to the satisfaction of the Examiner.
6. Note the previous comments regarding the reasons for indicating claims 1-8, 10, and 12-14 allowable as set forth in the Office Action dated March 25, 2005.

Response to Arguments

7. Applicant’s arguments, see the response, filed June 27, 2005, with respect to the rejection(s) of claim(s) 15-16 under 35 USC 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Beck (GB 1 407 065).

Conclusion


8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Taylor et al. (EP 1 147 912 A2), and GB 1 534 403 each teach security or copy proof documents including metamerism markings having obvious similarities to the claimed subject matter. Additionally, MacAndrew (US 4,903,079) and Folkins et al. (US 4,922,298) teach the use of a tungsten illumination source in a photocopier is well known in the art. See column 3, lines 35-43 of MacAndrew and column 4, lines 51-60 of Folkins et al.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(571) 272-2161**. The examiner can normally be reached on M-Th 7:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Leslie J. Evanisko
Primary Examiner
Art Unit 2854

lje
October 14, 2005